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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,297	01/11/2007	Rainer Berghaus	0690-0127PUS1	9833

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EXAMINER

KLINKEL, KORTNEY L

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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09/04/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/566,297	Applicant(s) BERGHAUS ET AL.	
	Examiner Kortney Klinkel	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

NOTE: Claims 31-33 provide for the use of an alkoxylated alcohol but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Furthermore, the claimed invention outlined by claims 31-33 is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). Accordingly, these claims have not been further treated on the merits. Should Applicants amend these claims to recite proper method claims as per standard US practice, they will be held to the same restriction requirement discussed below, namely they will be limited to a single species of composition.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. The inventions listed as Groups I(a)-I(m) do not relate to a single general inventive concept under PCT Rule

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13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature linking the species are compositions comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art.

In the present case, Eicken et al. (US 6420605) teaches compositions comprising at least one benzamide oxime derivative of the same generic group as instant formula (I) and at least one fatty alcohol polyglycol ether which falls within the generic term alkoxyated alcohol (see column 7, lines 19-25) as well as the generic structure depicted in claim 5 by formula (II). As a result, no special technical features exist among the claims because the inventions fail to make a contribution over the prior art. Accordingly, Groups I(a)-I(m) are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept and therefore, Applicants are restricted to a single disclosed species of invention.

Stated another way, the election of a single invention involves the election a single disclosed composition which involves the election of a single disclosed benzamide oxime derivative or derivatives and a single disclosed alkoxyated alcohol or alcohols, and/or one or more specific additional fungicides and/or specific additional auxiliaries. These choices are encompassed by the following generic groups.

Group I(a), claim(s) 1-5, 6, 8-10 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein according to figure (II), $m = 2$ and $n = 3$.

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Group I(b), claim(s) 1-5, 6, 8, 11-12 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein according to figure (II), $m = 2$ and $n = 5$.

Group I(c), claim(s) 1-5, 7 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein according to figure (II), $m = 2$ and $y = 0$.

Group I(d), claim(s) 1-5, 13-15 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein according to figure (II), $m = 3$ and $n = 2$.

Group I(e), claim(s) 1-5, 16-17 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein according to figure (II), $m = 5$ and $n = 2$.

Group I(f), claim(s) 1-5, 18 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein the alcohol is 2-propylheptanol.

Group I(g), claim(s) 1-5, 19-20 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein the alcohol is a C13 oxo alcohol obtained by hydrogenation of hydroformylated timeric butene.

Group I(h), claim(s) 1-5, 19, 21 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein the alcohol is a C13 oxo alcohol obtained by hydroformylated dimeric hexene.

Group I(i), claim(s) 1-5, 22-23 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, wherein the alcohol is a C10 oxo alcohol obtained by hydrogenation of hydroformylated timeric propene.

Group I(j), claim(s) 1-5, 24-25 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (Ia) and at least one alkoxyated alcohol.

Group I(k), claim(s) 1-5, 26-27 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, and at least one additional fungicide.

Group I(l), claims(s) 1-5, 28 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, and additional auxiliaries.

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Group I(m), claim(s) 1-5, 29 and 30 drawn to a composition comprising at least one benzamide oxime derivative of the formula (I) and at least one alkoxyated alcohol, at least one additional fungicide and one or more auxiliaries.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Due to the complicated nature of the restriction, the restriction requirement is being made via written correspondence in lieu of a telephone interview.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel, Ph.D. whose telephone number is

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(571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached at (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615